

REMARKS/ARGUMENTS

Claims 1-24 are pending. Claims 1 and 3 are currently amended for grammatical purposes. Claims 20-24 are added. New claim 20 finds support in original claims 1-4. New claim 21 finds support in original claim 19. New claims 22-24 find support in original claim 5. No new matter has been entered.

Claim 1 is also amended to clarify that the modified 1,3-bis(hydroxymethyl)-4,5-dihydroxyimidazolidin-2-one (modified DMDHEU) is a reaction product of 1,3-bis(hydroxymethyl)-4,5-dihydroxyimidazolidin-2-one (DMDHEU) with a modifying agent, namely a C<sub>1-5</sub>-alcohol, a polyol or a mixture thereof. Amended claim 1 finds support in the specification: pg 3, lines 1-4.

With respect to the 35 U.S.C. §102(b) rejection in view of *Gardiner*, Applicants submit that *Gardiner* does not anticipate Applicants' claims. *Gardiner* teaches a composition for impregnating timber that comprises an amino resin precursor containing reactive N-hydroxymethyl groups (Abstract). More specifically, *Gardiner* teaches urea-formaldehyde resin precursors or modified cyclic urea-derived resin precursors, such as DMDHEU (col. 2, lines 33-36). Applicants point out that *Gardiner's* modified cyclic urea-derived resin precursor being DMDHEU is not the same as a modified DMDHEU, which is claimed by Applicants. As stated above, *Gardiner's* amino resin precursor requires the presence of reactive N-hydroxymethyl groups which are consumed when the precursor reacts with an alcohol or polyol. Such reactive hydroxymethyl groups are not present in Applicants' modified DMDHEU. Accordingly, *Gardiner's* amino resin precursor does not anticipate Applicants' modified DMDHEU.

It should also be noted that *Gardiner's* modified polyol (with at least two alkyleneamido ether groups) does not correspond to Applicants' modified DMDHEU and therefore is also non-anticipatory.

Furthermore, Applicants submit that *Gardiner* does not render obvious Applicants' claims. Applicants' process uses a modified DMDHEU instead of a non-modified DMDHEU and *Gardiner* requires an amino resin precursor containing reactive N-hydroxymethyl groups which are not present in Applicants' modified DMDHEU. In addition, *Gardiner* does not teach, suggest or provide any motivation to replace the non-modified DMDHEU with a modified DMDHEU.

Moreover, Applicants' use of a modified DMDHEU instead of a non-modified DMDHEU provides unexpected results. More specifically, as seen in Tables 1 and 2 (reproduced below), modified DMDHEU (designated as "mDMDHEU") significantly decreases formaldehyde emission as opposed to non-modified DMDHEU.

Table 1

Wood	Treatment	Formaldehyde content	Improvement
Beech lamellae	30% DMDHEU; 1.5% $MgCl_2 \cdot 6 H_2O$	28.27*	
Beech lamellae	30% mDMDHEU; 1.5% $MgCl_2 \cdot 6 H_2O$	9.69*	66%

\* The concentration is stated in mg of formaldehyde per 100 g of wood

Table 2

Wood	Treatment	Formaldehyde content	Improvement
Pine sapwood lamellae	30% DMDHEU; 1.5% $MgCl_2 \cdot 6 H_2O$	19.11*	
Pine sapwood lamellae	30% mDMDHEU; 1.5% $MgCl_2 \cdot 6 H_2O$	7.91*	59%

\* The concentration is stated in mg of formaldehyde per 100 mg of wood.

Additionally and unexpectedly, the hardness of the wood is still increased by Applicants' process even though reactive hydroxymethyl groups are not present (specification: pg 6, lines 26-29, and pg 7, lines 31-33 --- reproduced below).

Wood	Brinell hardness	Improvement
Untreated	35 N/mm <sup>2</sup>	
Treated	73 N/mm <sup>2</sup>	109%

Wood	Brinell hardness	Improvement
Untreated	16 N/mm <sup>2</sup>	
Treated	30 N/mm <sup>2</sup>	88 %

Accordingly, *Gardiner* does not render obvious Applicants' claims.

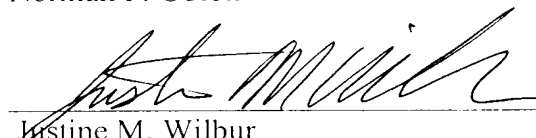
With respect to the double patenting rejection, a terminal disclaimer can be filed, if the claims in the present application remain obvious in view of the claims of the cited U.S. co-pending patent application at the time of allowance of the present application. Furthermore, additional amendments (if needed for allowance of these claims) may eliminate the double-patenting rejection, making the filing of a Terminal Disclaimer at this time premature. Indeed, M.P.E.P. § 804.02 IV states that, prior to issuance, it is necessary to disclaim each one of the double patenting references applied. Hence, Applicants respectfully request that the examiner contact the undersigned should the present amendments and arguments be accepted and should the present application be otherwise in a condition for allowance. At that time, a terminal disclaimer if warranted can be supplied to expedite issuance of this case.

Application No. 10/529,902  
Reply to Office Action of August 13, 2007

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

A handwritten signature in black ink, appearing to read 'Justine M. Wilbur', is written over a horizontal line.

Justine M. Wilbur  
Attorney of Record  
Registration No. 59,678

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)